REMARKS

Claims 1-23 are pending and stand rejected. Claims 1, 2, 5, 6, 12, 19, and 20 have been amended. In light of those amendments and the following remarks, the Applicant respectfully requests that the Examiner withdraw the rejection and pass the application on to issuance.

Claim Rejections – 35 USC §112: The Examiner rejected Claims 1-23 under §112 for failing to comply with the written description requirement. Each of Claims 1-23, directly or indirectly, recites "selecting an imaging conversion program from a plurality of imaging conversion programs based on a criterion." The Examiner asserts that the Specification fails to provide:

> any indication and/or teaching of the process of selecting an imaging conversion program from a plurality of imaging conversion programs based on a criterion in the disclosure, hence, the above claimed limitation presents new subject matter situations and was not described in the specification in such a way as to reasonable convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Applicant respectfully disagrees. Paragraphs [0003] – [008] repeatedly discuss the selection of an imaging conversion program based on a criteria. The explicit use of the term select and selecting with respect to an imaging conversion program at least infers that there are more than one imaging conversion programs to select from.

Paragraph [0179] of the Specification discusses a web based conversion service operating at a web site and states that the "web site would further include one or more image conversion programs 1230" depicted in Fig. 12. Here the Specification expressly discusses the presence of a plurality of image conversion programs.

Furthermore, paragraph [0185] of the Specification discusses determining, "based on the style sheet, and/or the desired format information from block 1340, or via another convenient method, which imaging conversion program to select and activate to process the content." Here the Specification expressly discusses the selection of

7

one of the image conversion programs according to a criteria – the criteria, in this example, being a style sheet and/or a desired format information.

Therefore, the recitation of "selecting an imaging conversion program from a plurality of imaging conversion programs based on a criterion" finds ample support in the Specification and is described in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections – 35 USC §112: The Examiner rejected Claims 2 and 3 under §112 citing a lack of antecedent basis for the term "web service." Claim 2 has been amended to address the Examiner's concerns.

Claim Rejections – 35 USC §102: The Examiner rejected Claims 1-4, 6-12, and 17-23 under §102 as being anticipated by US Pub. 2004/0205613 to Li. Li is directed to automatic transformation of data communicated between parties in a computing network. *See, e.g.,* Li, Title and Abstract. Li teaches the use of a style sheet or template to transform a document from one format to another. Li, Para [0041].

To implement Li's methods, Li discloses a server (306) that includes a transformation web service intermediary (Intermediary 301), registration service (302), transformation service (303), forward service (304), and receive service (305). Li, Para. [0052]. Transformation service (303) is a program responsible for transforming a document from one format to another. Li, Para. [0052]. Based on an incoming request (311), the intermediary (301) invokes the services of registration service (302), transformation service (303), forward service (304), or receive service (305). Li, Para. [0052]. In other words, if an incoming request (311) is for a transformation, then the intermediary (301) invokes the transformation service (303).

Claim 1 is directed to a method for providing imaging conversion services on content and, as amended, recites the following acts:

8

1. receiving content comprising non-image data;

2. obtaining a style sheet defining a conversion of the received content to a converted content;

3. determining a desired format for a desired destination for the content;

4. selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format;

5. converting the content using the selected imaging conversion program and the style sheet to obtain the converted content; and

6. transmitting the converted content to the desired destination.

Li does not disclose or suggest obtaining a style sheet defining a conversion of the received content to a converted content, determining a desired format for a desired destination for the content, and then selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format. As noted by the Examiner, Li simply discusses the selection of templates which the Examiner equates with the imaging conversion program of Claim 1. In paragraph [0022], Li mentions that a template may be specified using a style sheet. Li makes no mention of selecting a particular template based on both a style sheet and a desired format for a desired location to which the converted content is ultimately transmitted.

For at least this reason Claim 1 is patentable over Li as are Claims 2-18 and 21 which depend from Claim 1.

Claim 19 is directed to a system for implementing the method of Claim 1. For the same reasons Claim 1 is patentable, so are Claim 19 and Claim 22 which depends from Claim 19.
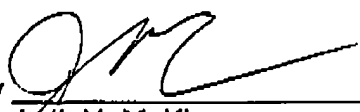
Claim 20 is directed to a computer readable medium containing code for implementing the method of Claim 1. For the same reasons Claim 1 is patentable, so are Claim 20 and Claim 23 which depends from Claim 20.

9

S/N: 09/923,337
Case: 10007652-1
Response to Office Action

Claim Rejections – 35 USC §103: The Examiner rejected Claim 5 as being unpatentable over Li in view of USPN 6,785,022 issued to Todaka. Claim 5 depends from Claim 1 and includes all the limitations of that base Claim. For at least the same reasons Claim 1 is patentable, so is Claim 5.

The Examiner rejected Claims 13-16 as being unpatentable over Li in view of a publication titled "Using Style Sheets to Publish XML to the Web." Claims 13-16 each depends from Claim 1 and includes all the limitations of that base Claim. For at least the same reasons Claim 1 is patentable, so are Claims 13-16.

Conclusion: In view of the foregoing remarks, the Applicant respectfully submits that the pending claims are in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

Shell S. Simpson

By _____

Jack H. McKinney
Reg. No. 45,685

April 6, 2006

10